

### REMARKS

Claims 1 and 24 have been amended. Claims 3-7, 11, 12, 16-18, 20-23 and 26 have been cancelled, and claims 10, 19 and 25 were previously canceled. No new matter has been added. Claims 1, 2, 8, 9, 3-15 and 24 are pending.

The Examiner and the SPE are thanked for their time discussing the un-entered amendment after final. There were a series of short discussions between July 23 and August 1, 2007. The Examiner and the SPE kindly provided some comments on the amendment after final.

In preparing the amendments, the undersigned observed that the Examiner had rejected all pending claims as anticipated, *except for claim 3*. Thus, claims 1 and 24 were amended to incorporate the subject matter of claim 3, and claim 3 was canceled. With this as a basis, further amendments were made to address the Examiner's concerns about the form of the independent claims. This is discussed further below.

Despite the considerable narrowing of the claims, it is believed that unclaimed subject matter is disclosed in the specification and claimable, and may be pursued in a continuation in the future. If this is done, the undersigned expects that narrow, definite claims will be presented. In this regard, the undersigned expresses appreciation at the high quality of the Examiner's search.

#### *Claim Objections*

The Examiner objected to claims 16-18 and 20-23 as being a substantial duplicate of other claims. This objection is respectfully traversed, and is now moot in view of the cancellation of claims 16-18 and 20-23.

#### *Claim Rejections - 35 USC § 112*

The Examiner rejected claims 1-9, 11-18, 20-24 and 26 under 35 USC § 112, first paragraph as failing to comply with the written description requirement. The Examiner stated, "The

specification fails to provide the requisite description to practice the very broad and generic monitoring method.” This rejection is respectfully traversed.

During the aforementioned interviews, the undersigned understood that the Examiner and the SPE stated that they believed the specification lacks sufficient written description to support the claims. In particular, it was understood by the undersigned that they indicated that there is insufficient description in the specification of how to select a condition to be monitored, or how to select a monitoring material.

The step of selecting a condition, and the step of selecting a monitoring material, have been deleted from claims 1 and 24. The claims are now better focused on the invention. As a consequence, the § 112, ¶ 1 rejection is now moot. In any event, and even though it is no longer relevant to the claims, the specification provides sufficient guidance to the skilled artisan in selecting conditions and monitoring materials. For example, conditions to be monitored are discussed in paragraphs 22-25 and 45. Monitoring materials are discussed in paragraphs 26, 28, 44. It is respectfully submitted that even an ordinary physician, after selecting a condition to monitor, could select from known materials to use for monitoring. The specification need not identify every condition and every material, since these things are merely peripheral to the invention, and the specification provide sufficient guidance for one of ordinary skill in the art to select conditions and materials.

As a further basis for rejection under 35 USC § 112, first paragraph, the Examiner pointed to the limitation “not diagnosing” as not disclosed in the specification. That phrase has been deleted from the claims. Withdrawal of the § 112, ¶ 1 rejection is therefore requested.

The Examiner rejected claims 1-9, 11-18, 20-24 and 26 under 35 USC § 112, second paragraph as indefinite. This rejection is respectfully traversed. The Examiner indicated that the claims used improper *Markush* wording. The *Markush* wording in the claims has been deleted. Withdrawal of the § 112, ¶ 2 rejection is therefore requested.

*Claim Rejections - 35 USC § 102*

The Examiner rejected claims 1, 2, 8, 9, 3-15 and 24 under 35 USC § 102(b)&(e) as anticipated by various references. This rejection is respectfully traversed. As explained above, claim 3 was not rejected under § 102. The limitation of claim 3 ("under the nail tissue") has been added into independent claims 1 and 24, and all other independent claims have been cancelled. Accordingly, all claims now appear to define over the prior art of record. Withdrawal of the § 102 rejection is therefore requested.

*Conclusion*

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned registered practitioner to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Date: August 2, 2007



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Appl. No. 10/692,364  
Amdt. Dated 8/2/2007  
Preliminary Amendment

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